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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,744	03/23/2004	Herbert Reyes	PU2196	2743
23454	7590	01/26/2006	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 01/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,744

Applicant(s)

REYES ET AL.

Examiner

Sebastiano Passaniti

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 03/23/2004 – application papers filed; 10/12/2004 – Response to Notice to File Corrected Application Papers; 10/20/2005 – Status Inquiry.

Claims 1-41 are pending.

Following is an action on the MERITS:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-18, 21-24 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over JACOBSON in view of SAEKI. As to claims 1, 10, 21, 22 and 37, the patent to Jacobson differs from the claimed invention in that Jacobson does not provide a plating as specific as required by the claims. Saeki shows it to be old in the art to provide either an iron-type or wood-type club head with a nickel-based plating by means of electroplating in order to provide superior corrosion resistance and reduce wear or deterioration of the color of the head after repeated exposure to the elements. See col. 1, lines 38-45 and col. 5, lines 1-12 in Saeki. Moreover, Saeki provides that the plating may be made a part of the entire head or only a selective portion of the head, such as the sole. See col. 4, lines 51-56 in Saeki. In view of the patent to Saeki, it would have been obvious to modify the device in the cited art

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reference to Jacobson by incorporating a plating on the exterior of the magnesium body, the motivation being to limit corrosion and improve the wear resistant qualities of the club head.

As to claims 2 and 12, Saeki obviates the use of a plating thickness, as needed. See col. 4, lines 62-68. Clearly, the skilled artisan would have found it obvious to modify the thickness of the coating based upon the particular requirements associated with the head, i.e., the base material of the head, overall weight of the head, or cost.

As to claims 3-8, 13, 14 and 24, it would appear that the skilled artisan would have been aware of the specific properties of each of the claimed elements (zinc, tin-cobalt, chromium, copper, medium phosphorous or high phosphorous alloy) and would have known how the addition of each of these elements would have affected the nickel-based plating. One skilled in the art would have known that these elements are combinable in a manner that enhances the plating process and therefor would have found it obvious to incorporate whatever suitable materials to provide a plating that, for example, sufficiently adheres to a magnesium club head base.

As to claims 11, 21, 22 and 37, Jacobson shows a face component and an aft-body component. As for the specific claimed dimensional requirements of the face component, see col. 10, lines 43-63.

As to claim 15, see col. 8 lines 18-50 in Jacobson, wherein an injection molding process is outlined for forming the metal aft-body.

As to claims 16 and 38, see col. 14, lines 32-40 in Jacobson, wherein the volume of the head as ranging from 290 to 600 cubic centimeters is outlined.

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As to claims 17 and 39, see the discussion of moment of inertia in col. 16, lines 28-36 in Jacobson.

As to claims 18, 23 and 40, note the materials for the face component outlined in col. 6, lines 51-65 in Jacobson.

As to claim 21, see col. 8, lines 50-65 in Jacobson for a description of the thickness parameters for the aft-body. As for the thickness of the striking plate portion, see again col. 10, lines 43-63.

As to claim 41, see col. 6, lines 51-65, wherein titanium is disclosed for the face component.

Claims 9, 19, 20 and 25-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over JACOBSON in view of SAEKI and CHAPPELL. Jacobson in view of Saeki has been discussed above.

As to claim 9, to have provided a coating with a Rockwell Hardness greater than 50C in order to provide superior corrosion resistance and provide a hard surface for the outer shell in the Jacobson device would have been obvious to one of ordinary skill in the art in view of the patent to Chappel, which shows it to be old in the art to incorporate a hard coating, with a Rockwell Hardness greater than 50C in order to improve club head durability. See col. 1, line 34 through col. 2, line 12 in Chappell.

As to claims 19, 20 and 25-36, it is well-established that deionization of the base surface prior to plating creates an environment where maximum adhesion of the plating material may occur. The teaching reference to Chappell obviates the use of a preparation procedure for preparing the club head main body prior to plating the core.

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See col. 3, line 39 through col. 4, line 29 in Chappell. The skilled artisan would have found it obvious to incorporate any known plating process based upon the specific preparation needed for the specific plating material used. Moreover, it would appear that the skilled artisan would have been aware of the specific properties of each of the claimed elements that are further added to the plating and would have known how the addition of each of these elements would have affected the nickel-based plating. One skilled in the art would have known that these elements are combinable in a manner that enhances the plating process and therefor would have found it obvious to incorporate whatever suitable materials to provide a plating that, for example, sufficiently adheres to a magnesium club head base.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
January 23, 2006


Sebastiano Passaniti
Primary Examiner